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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/638,989	08/11/2003	Robert Greenberg	S230-USA	6557
28284 7590 12/09/2010 SECOND SIGHT MEDICAL PRODUCTS, INC. 12744 SAN FERNANDO ROAD BUILDING 3 SYLMAR, CA 91342				
EXAMINER DIETRICH, JOSEPH M				
ART UNIT		PAPER NUMBER		
3762				
NOTIFICATION DATE		DELIVERY MODE		
12/09/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

SCOTT@2-SIGHT.COM  
REVANS@2-SIGHT.COM

### Office Action Summary

**Application No.**

10/638,989

**Applicant(s)**

GREENBERG ET AL.

**Examiner**

Joseph M. Dietrich

**Art Unit**

3762

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 May 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 August 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
- \_\_\_\_\_ Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- \_\_\_\_\_ Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 19, 2010 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1 – 15 have been considered but are moot in view of the new ground(s) of rejection, necessitated by amendment.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 26 - 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification, as originally filed, fails to

disclose "cleaning said rigid subject" as recited in claim 26. Thus, the claim constitutes new matter. If applicant believes there is sufficient support for the claim, citations are requested.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 26-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Milojevic et al. (US PGPUB 2004/0147825) in view of Sheppard et al. (US PGPUB 2002/0187260).

Regarding **claim 26**, Milojevic discloses choosing a rigid substrate (e.g. 42 and paragraph 52); cleaning said substrate (e.g. paragraph 94 and 248); depositing a first

polyparaxylylene layer on the substrate (e.g. paragraph 248); depositing an electrical conductor on the polyparaxylylene layer (e.g. paragraph 90); patterning the conductor to form a conductive path (e.g. paragraph 90). Sheppard teaches it is known to deposit a second polyparaxylylene layer (e.g. paragraph 14) and remove at least a portion of the second layer defining at least one aperture therein (e.g. paragraph 16). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the step of depositing a first polyparaxylylene layer as taught by Milojevic with depositing a second polyparaxylylene layer as taught by Sheppard, since such a modification would provide the predictable results of providing further insulation around the conductive wires.

Regarding **claim 27**, Milojevic discloses a substrate, as previously mentioned. Sheppard teaches it is known to choose a substrate comprised of glass (e.g. paragraph 29). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the substrate as taught by Milojevic with the glass substrate as taught by Sheppard, since such a modification would provide the predictable results of using a cost-effective readily available substrate.

Regarding **claims 28 – 32**, Milojevic discloses depositing a polyparaxylylene layer, as previously mentioned. Sheppard teaches it is known to apply silane and/or modify the polyparaxylylene layer by chemical means in order to enhance the layer for adhesion (e.g. paragraph 80). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the depositing of the polyparaxylylene layer as taught by Milojevic with enhancing the layer for adhesion as

taught by Sheppard, since such a modification would provide the predictable results of effectively adhering the substrate, polyparaxylylene layers and conductive paths to one another.

Regarding **claims 33 and 34**, Milojevic in view of Sheppard discloses enhancing the polyparaxylylene layer for adhesion, as previously mentioned. Examiner takes official notice that the steps of roughening a layer and compressing two layers thermally are well known methods of enhancing a layer for adhesion. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the enhancing of the polyparaxylylene layer as taught by Milojevic in view of Sheppard with enhancing the polyparaxylylene layer using the steps of roughening a layer or compressing two layers thermally as is well known in the art, since such a modification would provide the predictable results of effectively adhering the substrate, polyparaxylylene layers and conductive paths to one another.

Regarding **claim 35**, Milojevic discloses the step of depositing a polyparaxylylene layer, as previously mentioned. Sheppard teaches it is known to remove at least one portion of the second polyparaxylylene layer by etching with reactive ions (e.g. paragraph 16). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the step of depositing a first polyparaxylylene layer as taught by Milojevic with depositing a second polyparaxylylene layer and removing portions of that layer by etching as taught by Sheppard, since such a modification would provide the predictable results of providing apertures through which the conductive wires can contact living tissue.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph M. Dietrich whose telephone number is (571)270-1895. The examiner can normally be reached on M-F, 8:00 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Layno can be reached on 571-272-4949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. M. D./  
Examiner, Art Unit 3762

/Scott M. Getzow/  
Primary Examiner, Art Unit 3762